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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/978,633	11/25/1997	ELAZAR RABBANI	ENZ-53	4639

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ENZO BIOCHEM, INC.
527 MADISON AVENUE (9TH FLOOR)
NEW YORK, NY 10022

EXAMINER

ANGELL, JON E

ART UNIT	PAPER NUMBER
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1635

MAIL DATE	DELIVERY MODE
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10/18/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of Non-Compliant Amendment (37 CFR 1.121)

Application No.

08/978,633

Examiner

J. Eric Angell

Applicant(s)

RABBANI ET AL.

Art Unit

1635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

The amendment document filed on 03 November 2006 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121 or 1.4. In order for the amendment document to be compliant, correction of the following item(s) is required.

THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☐ 1. Amendments to the specification:
 - ☐ A. Amended paragraph(s) do not include markings.
 - ☐ B. New paragraph(s) should not be underlined.
 - ☐ C. Other _____.
- ☐ 2. Abstract:
 - ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
 - ☐ B. Other _____.
- ☐ 3. Amendments to the drawings:
 - ☐ A. The drawings are not properly identified in the top margin as "Replacement Sheet," "New Sheet," or "Annotated Sheet" as required by 37 CFR 1.121(d).
 - ☐ B. The practice of submitting proposed drawing correction has been eliminated. Replacement drawings showing amended figures, without markings, in compliance with 37 CFR 1.84 are required.
 - ☐ C. Other _____.
- ☒ 4. Amendments to the claims:
 - ☐ A. A complete listing of all of the claims is not present.
 - ☐ B. The listing of claims does not include the text of all pending claims (including withdrawn claims)
 - ☒ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended).
 - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
 - ☒ E. Other: see attached.
- ☐ 5. Other (e.g., the amendment is unsigned or not signed in accordance with 37 CFR 1.4):

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714.

TIME PERIODS FOR FILING A REPLY TO THIS NOTICE:

1. Applicant is given **no new time period** if the non-compliant amendment is an after-final amendment or an amendment filed after allowance. If applicant wishes to resubmit the non-compliant after-final amendment with corrections, the **entire corrected amendment** must be resubmitted.
2. Applicant is given **one month**, or thirty (30) days, whichever is longer, from the mail date of this notice to supply the correction, if the non-compliant amendment is one of the following: a preliminary amendment, a non-final amendment (including a submission for a request for continued examination (RCE) under 37 CFR 1.114), a supplemental amendment filed within a suspension period under 37 CFR 1.103(a) or (c), and an amendment filed in response to a *Quayle* action. If any of above boxes 1. to 4. are checked, the correction required is only the **corrected section** of the non-compliant amendment in compliance with 37 CFR 1.121.

Extensions of time are available under 37 CFR 1.136(a) only if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action.

Failure to timely respond to this notice will result in:

Abandonment of the application if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action; or

Non-entry of the amendment if the non-compliant amendment is a preliminary amendment or supplemental amendment.

Legal Instruments Examiner (LIE), if applicable

Telephone No.

[Handwritten Signature]
Primary Examiner
Art Unit 1635

DETAILED ACTION

Response to Amendment

This Action is in response to the amendment filed on 11/3/2006.

The amendment to the claims filed on 11/3/2006 does not comply with the requirements of 37 CFR 1.121(c) for the following reasons.

First, it is noted that a preliminary amendment was filed 11/25/1997, which is the date the application was filed, wherein the preliminary amendment cancelled claims 1-244 and added claims 245-302. Since the “preliminary” amendment was filed the day the application was filed the claims submitted with the preliminary amendment are considered to be originally filed claims. It is noted that in most of the claims presented in the 11/3/2006 amendment that have not been amended since they were added in the 11/25/1997 amendment are correctly identified as “(original)” (e.g., see claim 246, 248, etc.). However, there are two claims that have been identified in the 11/3/2006 as “(previously presented)”, but these claims have not been amended since they were originally presented in the 11/25/1997 preliminary amendment. The two claim which have the incorrect status identifier are claims 245 and 272, which should be identified as “(original)”, which would be consistent with all other claims added in the 11/25/1997 preliminary amendment and which have not been amended. It is noted that the identifier “(previously presented)” refers to claims that have either been added after the original claims or which have been amended during prosecution. Since, the claims added in the preliminary amendment filed 11/25/1997 were added the day the application is filed, they are considered originally filed claimed, and should be identified accordingly and consistent with the other

Art Unit: 1635

similarly filed claims. Second, claim 284 comprises two changes from the immediate previous version of the claim which are not identified by the required text markings. Specifically, claim 284, line 4 now recites the phrase “component which- is in”. Here the hyphen after the word “which” is not present in the previous version of the claim, thus it must be identified using the proper text marking (i.e., it must be underlined) and here it is not. Also, claim 284, line 5 contains a “;” (i.e. a semicolon) after the word “form”. However, the previous version of the claim had a “,” (i.e., a comma). Therefore, this change should include the required text markings but it does not (i.e., the comma should be identified as deleted using double brackets and the semicolon should be identified as being added by underlining). Also, it is noted that claim 247 includes double brackets around the semicolon after the word “component” and also contains a strike-through over the semicolon after the word “interest”. Although the strikethrough of the semicolon is not technically incorrect, it is noted that 37 CFR 1.121(c) indicates that “double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters”. Applicants are asked to consider using double brackets to identify deletion of the single character semicolon after the word “interest” which would be easier to identify and would also be consistent with the double bracketing of the semicolon after the word “component” also in the same claim.

It is noted that the Examiner has tried his best to identify all issues non-compliant issues in the 11/3/2006 claim set. However, Applicants are urged to review the claims to make sure any future amendment is fully compliant with 37 CFR 1.121(c).

Applicants are respectfully reminded that amendments to the claims filed on or after July 30, 2003 must comply with 37 CFR 1.121(c) which states:

Art Unit: 1635

(c) *Claims.* Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

(1) *Claim listing.* All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of “canceled” or “not entered” may be aggregated into one statement (e.g., Claims 1–5 (canceled)). The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

(2) *When claim text with markings is required.* All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of “currently amended,” and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of “currently amended,” or “withdrawn” if also being amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as “withdrawn—currently amended.”

(3) *When claim text in clean version is required.* The text of all pending claims not being currently amended shall be presented in the claim listing in clean version, i.e., without any markings in the presentation of text. The presentation of a clean version of any claim having the status of “original,” “withdrawn” or “previously presented” will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of “withdrawn” or “previously presented.” Any claim added by amendment must be indicated with the status of “new” and presented in clean version, i.e., without any underlining.

(4) *When claim text shall not be presented; canceling a claim.*

(i) No claim text shall be presented for any claim in the claim listing with the status of “canceled” or “not entered.”

(ii) Cancellation of a claim shall be effected by an instruction to cancel a particular claim number. Identifying the status of a claim in the claim listing as “canceled” will constitute an instruction to cancel the claim.

(5) *Reinstatement of previously canceled claim.* A claim which was previously canceled may be reinstated only by adding the claim as a “new” claim with a new claim number.

Art Unit: 1635

It is noted that since the amendment is not compliant with 37 CFR 1.121(c), the amendment has not been entered. Therefore, any future amendment should be based on the immediate previously entered claims (i.e., the claims examined in the previous Office Action on the Merits).

Since the reply filed on 11/3/2006 appears to be *bona fide*, applicant is given a TIME PERIOD of **ONE (1) MONTH** or **THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to submit an amendment in compliance with 37 CFR 1.121 in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Eric Angell whose telephone number is 571-272-0756. The examiner can normally be reached on Monday-Thursday 8:00 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Douglas Schultz can be reached on 571-272-0763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1635

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. E. Angell/
Primary Examiner
Art Unit 1635